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S.N. 09/684,032

Docket No. 420-002

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
:
CHRISTOPHER S. NOLAN :
:
Serial No. 09/684,032 : Group Art Unit: 3652
:
Filed: October 6, 2000 : Examiner: Charles A. Fox
:
For: **LINER FOR CONTAINER** :
WITH SIDE DOOR :

APPEAL BRIEF

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Commissioner for Patents
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Dear Sir:

Appeal is taken from the final rejection of claims 1-11 on April 23, 2003. A timely Notice of Appeal was filed on July 22, 2003. The fee for submitting this Appeal Brief may be debited from Deposit Account 11-0978, along with any other fees required.

I. REAL PARTY IN INTEREST

The inventor assigned 100% of his interest in the present invention to Eagle Protective Plastics, Inc., an Indiana Corporation having a place of business at 222 West 6th Street, Jeffersonville, Indiana, 47130.

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II. RELATED APPEALS AND INTERFERENCES

The appellants and appellants' legal representative know of no other appeals or interferences which will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1-11 remain pending in the application and are the subject of this appeal.

Claims 1, 2, 4-6, 9, and 10 are finally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 3,951,284 to Fell et al. when considered alone.

Claims 3, 7, and 11 are finally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over '284 to Fell et al. in view of U.S. Patent No. 5,028,197 to Krein et al.

Claim 8 is finally rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over '284 to Fell et al. in view of '197 to Krein et al. and further in view of U.S. Patent No. 5,746,862 to Derby.

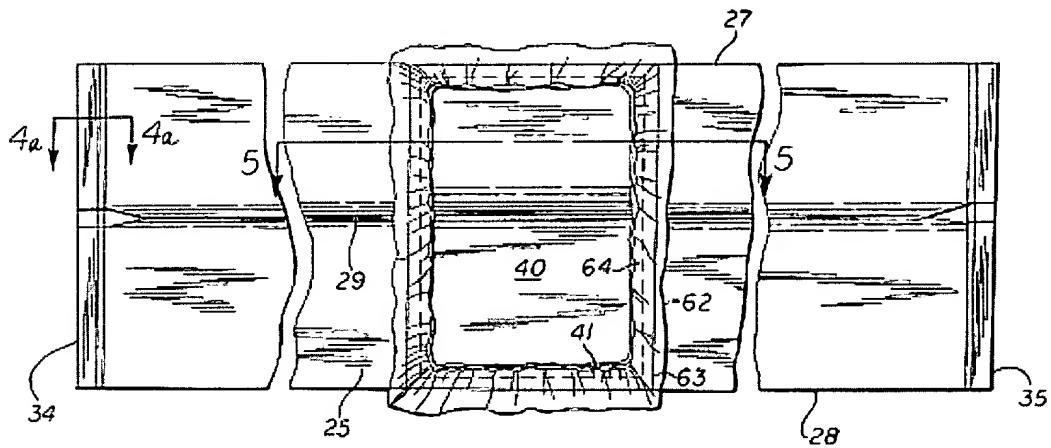
IV. STATUS OF AMENDMENTS

The form of the claims for purposes of this appeal is the same as originally filed October 6, 2000.

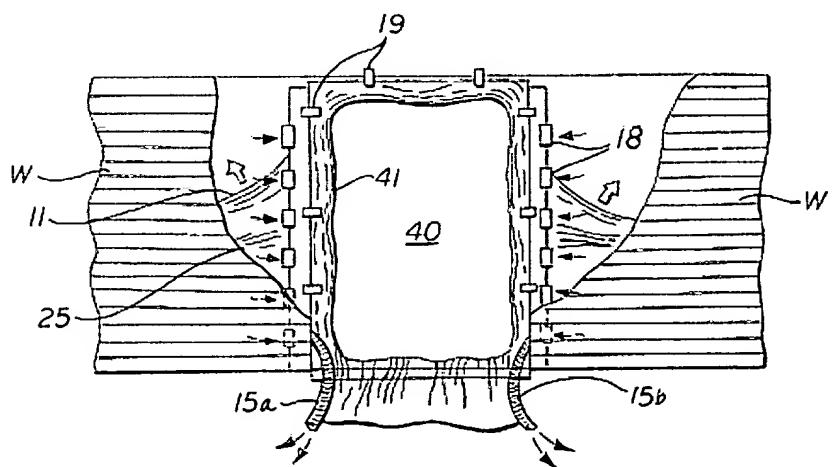
V. SUMMARY OF THE INVENTION

The present invention pertains to moisture proof liners for containers and, more particularly, to a liner and the related installation system where transfer of the cargo into and

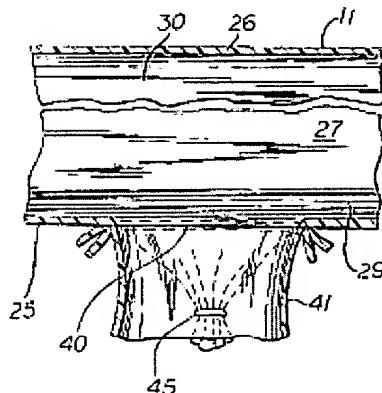
out of the container is through a side door. In its broadest terms, the invention includes an liner 11 formed of impervious film having a first, elongated side panel 25, an opposite side panel 26, a top panel 27, a bottom panel 28, and first and second end panels 34 and 35:



An access opening 40 is formed in at least the one side panel 25, such as for example by cutting, and is adapted for loading and unloading cargo from the side of the liner:



Independent claim 1 relates specifically to the liner 11 comprising four elongated panels 25, 26, 27, 28 of impervious film adapted to substantially match the elongated sides, top, and bottom of a container 10 (as shown in Figure 4, supra). First and second end panels 34 and 35 complete the liner (also Figure 4). The liner 11 also comprises an access opening 40 along at least one side panel adapted for loading and unloading cargo (Figure 2, supra). A closure 45 is also claimed for sealing the opening 40:



Claim 2 adds an open tube 41 attached at one end to extend laterally from the opening to form a passage for loading and unloading cargo (Figure 5; p. 9, line 11). Claim 3 adds to claim 2 the condition that the liner and tube are formed of plastic sheet (p.8, line 15) and that a heat seal bead 64 extends around the orifice between one side panel and the adjacent one end of the tube 41 (Figure 4; p. 11, line 12). Claim 4 adds a tie closure 45 formed around the tube 41 and adapted to be tucked inside the container after loading (Figure 5; p.9, line 21). Claim 5 adds the requirement that the access opening 40 is located at approximately

the mid-point of one of the side panels 25 (Figure 1; p. 10, line 1).

Claim 6 requires that the liner in claim 1 include a second access opening 40a, a tube 41a in the second side panel substantially opposite the first opening, and a closure 45a for the second opening for loading/unloading cargo (Figure 3; p. 10, line 8).

Claim 7 adds the requirement of gussets 29, 30 thereby allowing expansion for substantially filling the container when the panels are fully extended (Figures 4 & 5; p. 8, line 22). Claim 8 adds the requirement that the first and second end panels 34,35 are formed by folded end sections of the gusseted side panels and a heat seal bead 60 extending across the gussets of the end sections (p. 10, line 22).

Independent claim 9 relates to a method of installing a moisture proof liner for an elongated container, including the step of providing a liner 11 having four elongated panels of impervious film adapted to substantially match the elongated sides 25, top 27 and bottom 28 of the container. The liner 11 also includes first and second end panels 34,35. The method further includes the step of cutting an access opening 40 along at least one side panel 25 adapted for loading and unloading cargo, as well as the step of positioning the liner 11 in the container. The method involves erecting the liner to substantially fill the container, transferring cargo through the opening, and closing the opening to seal the liner and protect the cargo (Figures 4 & 5; p. 10, line 14).

Claim 10 adds the requirement to claim 9 that the method include the step of attaching

an open ended tube 41 to the one side panel to mate with the opening 40 (p.9, line 12). Additionally, the method of claim 10 includes passing cargo through both the tube 41 and the opening 40 during cargo transfer (p. 9, line 13). Claim 11 adds the step of holding open the free end of the tube overhead by lifting the upper corners and providing protection from inclement weather during cargo transfer (p. 9, line 15).

VI. THE ISSUES

The Board must first determine whether the inventions set forth in claims 1, 2, 4-6, 9, and 10 are “obvious” under 35 U.S.C. §103(a) in view of the teachings of a single reference, U.S. Patent No. 3,951,284 to Fell et al. Additionally, the Board must determine whether claims 3, 7, and 11 are rendered “obvious” by U.S. Patent No. 3,951,284 to Fell et al. in view of U.S. Patent No. 5,028,197 to Krein et al. Finally, the Board must determine whether claim 8 is “obvious” over U.S. Patent No. 3,951,284 to Fell et al., in view of U.S. Patent No. 5,028,197 to Krein et al., in view of U.S. Patent No. 5,746,862 to Derby.

VII. GROUPING OF CLAIMS

Independent claim 1 and dependent claims 2-4 stand or fall together. Dependent claims 5, 6, 7, and 8 stand alone. Independent claim 9 and dependent claims 10-11 stand or fall together.

VIII. ARGUMENT

None of the Cited References Render Obvious the Inventions of Claims 1-11.

As set forth above, claim 1 expressly requires a moisture proof liner for an elongated container for use in shipping cargo comprising four elongated panels of impervious film adapted to substantially match the elongated sides, top and bottom of the container and first and second end panels to complete the liner. An access opening is provided along at least one side panel for loading and unloading cargo, and a closure seals the liner against moisture to protect the cargo. As explained in detail in the Background of the Invention section of appellant's specification, the need met by the present invention is "providing a system for cargo shipping containers, characterized by a side, rather than end door for transfer of the cargo into and out of the container." Method claim 9 requires, *inter alia*, the steps of "providing . . . [a] liner having four elongated panels" including for covering the sides, top, and bottom of . . . [a] container" and "cutting an access opening along at least one side panel."

The inventions recited in claims 1 and 9 are in stark and total contrast to the liner disclosed in the Fell '284 patent, which as admitted by the Examiner simply does not teach a liner having an opening on a side panel corresponding to the top, bottom, or side of an elongated container. Rather, it shows the conventional opening formed in the end panel of the liner, which obviously would not meet the need identified by the appellant and fulfilled by the inventions of claims 1 and 9. Accordingly, since these claims clearly distinguish

between the end panels and the side panels and plainly describe the location of the opening, it is believed that the '284 patent does not suggest the inventions claimed therein. Since no other evidence is cited as allegedly supplying the teaching missing from this reference or suggesting this modification, it is respectfully submitted that a *prima facie* case of obviousness is lacking. *See* Manual of Patent Examining Procedure § 2143.03 (stating that “[t]o establish *prima facie* obviousness of a claimed invention, ***all claim limitations must be taught or suggested by the prior art***”) (emphasis added) (citations omitted).

Precedential decisions of the Court of Appeals for the Federal Circuit fully support appellant's position in this regard. For example, in the decision of *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), the Federal Circuit overturned an Examiner's determination regarding the obviousness of a claimed invention, explaining that:

[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.*

Id. at 1784 (emphasis added). The highlighted point was further emphasized in the more recent decision of *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), in which the court held that the Board of Patent Appeals and Interferences improperly relied upon “common knowledge

and common sense” of a person of ordinary skill in the art to find a claimed invention obvious. Instead, the court emphasized the need for “*objective evidence*” on this point, as opposed to subjective speculation.

Here, not even a scintilla of objective evidence indicates that anything in the prior art “suggested” the Examiner’s proposed modification to the liner disclosed in the Fell et al. patent. Rather, the only mention is that a “similar” liner could be “applied to a shipping vehicle having side walls and opening doors in at least one of the walls” (col. 30, lines 30-32). Indeed, while it is easy for the Examiner using hindsight to conclude subjectively that the invention of claim 1 is “obvious,” ostensibly because it is not terribly complex technology, the position advanced fails to consider that the only suggestion in Fell et al. is to provide a liner with an opening in a narrow end panel of a liner, and to use a “similar” (i.e., nearly exactly the same) liner in a shipping vehicle having “side walls”. While the end opening admittedly corresponds to the door of the container (which may be on a “side” of the container), this does not fairly support the conclusion that it would thus be “obvious” to provide the opening in a different, elongated side panel of the liner, merely to accommodate a door in a “side” wall of a type of container not even shown in the reference. This is simply speculation based on hindsight using the appellant’s teaching as a blueprint, which is of course never proper. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation” to

make a modification as an “essential evidentiary component of an obviousness holding”); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion “essential” to avoid hindsight); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”).

Appellant concedes that the Fell et al. patent “suggests” and, in fact, expressly discloses providing an opening in an end panel of a liner. However, if a “similar” liner with the opening in the end panel as disclosed in the Fell et al. patent were used in an elongated container with a side door, *it would not work!* This is because the liner disclosed in this patent includes elongated side panels and short end panels, and it is one of the short end panels that includes the “access” opening. If such a liner were inserted in a container with a door or opening in an elongated side, the corresponding side panels would face the short ends of the container when erected, and thus would not match (as required in both claims 1 and 9). Moreover, these elongated sides could not be moved into contact with the ends of the container in an easy and efficient manner, such as by using positive or negative air pressure. Instead, some deformation or stretching of these panels would be required to make the rearrangement, which is not only extraordinarily difficult to accomplish, but also deleteriously risks tearing or perforating the liner (which even the Fell et al. patent acknowledges is of critical importance). Since a moisture-proof liner is required by the industry, such tearing

would essentially render it ineffective for its intended purpose.

Additionally, if a second access opening is added to the elongated side panel of the Fell et al. liner to accommodate a container with a side door, the Examiner fails to explain how one would deal with the openings in the end panel, which would ostensibly face a side wall of the container and would be rendered useless. If the position is that the end openings would simply be moved to the side, this is a *structural modification* of the prior art without any teaching or suggestion to do so. Even if this patent is presumed to disclose that the opening is provided adjacent to a door in the container, this cannot be considered *per se* to teach or suggest what is now being claimed: a liner with an elongated side having an access opening, which is intended for use in a container having a side door, when in fact there is nothing in the reference to suggest such an arrangement.

Simply put, the Fell et al. patent does not even contemplate providing an access opening in an elongated side panel of a liner, as opposed to the end panel. Rather, like all cited prior art, it simply discloses the conventional access opening in the end panel. As explained above, the two liners are not interchangeable, and no prior art arising in the nearly 30 years since the application that matured into the Fell et al. patent is identified that suggests the modification made by the appellant or a corresponding method of use, as now embodied in claims 1 and 9. This belies the position that it would have been “obvious” to simply place the opening at the location corresponding to the door in the container, which is based on

subjective speculation alone, rather than the “objective” evidence that the precedential case decisions expressly require.

As noted above, the suggested rearrangement requires a substantial reconstruction or redesign of the liner described therein (stated another way, a “structural modification”). In the case of *In re Ratti* 123 USPQ 349 (CCPA 1959), the Court of Customs and Patent Appeals encountered a similar situation regarding an Examiner’s assertion of “obviousness” that would have required a substantial redesign of the device disclosed in the prior art. The CCPA found that the Examiner’s assertion of “obviousness” was improper because the combination of references relied on required “substantial reconstruction and redesign of the elements shown.” Specifically, the court observed that:

[w]e hold, further, that the combination of [references] . . . is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [reference 1] as well as a change in the basic principles under which the . . . construction was designed to operate. Once appellant had taught how this could be done, the redesign may, by hindsight, seem to be obvious to one having ordinary skills. . . However, when viewed as of the time appellant’s invention was made, and without the benefit of appellant’s disclosure, we find nothing in the art of record which suggest appellant’s novel [invention] . . .

Id. at 352 (emphasis added). Similarly, in *Ex parte Chicago Rawhide Manufacturing Company*, 223 USPQ 351(Bd. Pat. App. & Inter.1984), the Board rejected an Examiner’s assertion of “obviousness,” recognizing that the elements of the cited prior art must be arranged in a different manner from that disclosed in the cited references. In particular, the

Board observed that:

In our view the here claimed subject matter would not have been obvious within the meaning of 35 USC 103 based solely on the [reference]. As correctly urged by the appellant, and as apparently recognized by the Examiner, in order to meet the terms of the claims on appeal, the elements of the . . . device would have to be arranged in a manner different from that disclosed The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness.

Id. at 353 (emphasis added).

As admitted by the Examiner, the '284 patent *only* shows the conventional opening formed in the end panel of the liner, and suggests that a "similar" liner (i.e., one with an opening in a narrow end panel) could be "applied to a shipping vehicle having side walls." Just like in *Ex parte Chicago Rawhide* and *In re Ratti*, the assertion that it would be "obvious" to rearrange the prior art liner to have an opening on an elongated side panel is specious, since such would require a "substantial reconstruction and redesign of the elements" of the '284 patent. As observed by the Board in *Ex parte Chicago Rawhide, supra*, "[t]he prior art must provide a motivation or reason for the worker in the art, *without the benefit of the appellant's specification*, to make the necessary changes in the reference device" (emphasis added). As fully established above, the '284 patent is lacking motivation or reason to make the changes in the reference device that the Examiner suggests. Therefore, the rejections of claims 1 and 9 on "obviousness" grounds are wholly improper and must be

reversed.

The rejections of dependent claims 5-8 must also fail for similar reasons. Claim 5 requires that the opening is *along the mid-point* of one of the elongated side panels. Since the Fell et al. patent does not even teach providing such an opening in a side panel, it certainly cannot teach or suggest providing it at a mid-point of an elongated side panel. Moreover, even if the opening in the liner disclosed in the Fell et al. patent were provided at the mid-point of the end panel (which it ostensibly is not, and the Examiner does not contend otherwise), it is emphasized that this liner would not work in a container with a side door, since the elongated sides of that liner would not “substantially” match the corresponding sides of the container. Rather than explaining why the Fell et al. patent suggests providing the opening at the midpoint (which it does not), the Examiner simply makes a “shotgun” rejection of this claim without providing any substantive analysis. The specific requirements of the claim are ignored, which is reversible error. *See* Manual of Patent Examining Procedure § 2143.03 (8th ed., rev. 1, February 2003) (recognizing in the obviousness context that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”).

As for claim 6, the Examiner contends that the Fell et al. patent teaches “access openings for containers having openings on one *or more* sides depending on the configuration of the container,” but cites to no portion of the document as supplying this

teaching. Appellant's Counsel has scoured this reference, but finds that it is limited to providing one or more access openings on a *single end panel* of a liner. It simply does not contemplate providing an opening in a second side panel substantially opposite the first opening, as expressly required by this claim. This is because the Fell et al. liner is for use on a trailer or other container including doors on only a single end. Thus, it certainly cannot "suggest" this modification, and no other convincing line of reasoning is proffered to explain why a skilled artisan would want to provide a second opening at the opposite end of the liner disclosed in the Fell et al. patent, when the opening would simply face the opposite end wall of the container, which is *always* closed.

Regarding claim 7, the Examiner's posits "that one of ordinary skill in the art of making a liner of this type would be familiar with a gusset," and in support of this theory uses a dictionary of the English language to (not surprisingly) find a definition of this word (which obviously was not coined by the appellant). This is the exact kind of approach rebuffed by the Federal Circuit in *In re Lee, supra*, where reliance on the "general knowledge" of those of skill in the art was rejected as proper evidence of obviousness. *See also* Manual of Patent Examining Procedure § 2143.01 (8th ed., rev. 1, February 2003) ("A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because . . . all aspects of the invention were individually known *is not sufficient to establish a prima*

*facie case of obviousness.”). Here, the liner in Fell et al. includes no gussets, and the Examiner does not apply any prior art against claim 7 that supplies this missing teaching. Thus, the objective evidence of obviousness is missing, as is the *prima facie* case thereof.*

With regard to claim 8, the Examiner admits that Fell et al. in view of Krein et al. “do not teach the end panels as being gusseted,” but contends that it would have been “obvious to use gussets” as allegedly taught in the Derby et al. patent. This argument completely overlooks the fact that claim 8 requires that the end panels are formed by “folded end sections” of the gusseted panels and a heat seal bead extending across the gussets. Despite twice having the opportunity to formulate a proper rejection of this claim, the Examiner completely overlooks the express wording used (which requires more than just gussets) and for unknown reasons persists in refusing to allow even one claim in the application. The rejection as made simply does not provide the necessary evidence to support a *prima facie* case of obviousness, since each and every limitation required is not found in the cited prior art or in any other objective evidence relied upon by the Examiner.

In summary, appellant has addressed and met every rejection set forth in the final Office Action and asseverates that all of the rejected claim meet the statutory requirements for patentability, and thus should be allowed. In particular, the manner in which claims 1 and 9 patentably distinguish over the ‘284 patent has been explained convincingly and in detail. The independent patentability of several of the dependent claims is also established, including dependent claims 5-8 which stand alone. Thus, it is respectfully requested that all

outstanding rejections of claims 1-11 be reversed and that the present application be remanded to the Examiner with instructions for immediate allowance.

Respectfully submitted,

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IX. APPENDIX

The claims on Appeal read as follows:

1. A moisture proof liner for an elongated container for use in shipping cargo, comprising:

four elongated panels of impervious film adapted to substantially match the elongated sides, top and bottom of said container;

first and second end panels to complete said liner;

an access opening along at least one side panel adapted for loading and unloading said cargo; and

a closure for said opening to seal said liner against moisture to protect the cargo.

2. The liner of Claim 1, wherein said access opening includes an open tube attached at one end to extend laterally from said opening to thereby form a passage for loading and unloading said cargo.

3. The liner of Claim 2, wherein said liner and said tube are formed of plastic sheet and a heat seal bead extending around said orifice between said one side panel and the adjacent one end of said tube.

4. The liner of Claim 3, wherein said closure is formed by a tie around the tube adjacent the other end and adapted to be tucked inside said container after loading.

5. The liner of Claim 1, wherein the access opening is approximately at the mid-point of said one side panel.

6. The liner of Claim 1, wherein is provided a second access opening including a tube in the second side panel substantially opposite the first opening for also loading/unloading said cargo and a second closure for said second opening.

7. The liner of Claim 1, wherein the side panels include gussets to allow expansion for substantially filling said container when said panels are fully extended.

8. The liner of Claim 7, wherein said first and second end panels are formed by folded end sections of the gusseted side panels and a heat seal bead extending across the gussets of said end sections.

9. A method of installing a moisture proof liner for an elongated container for use in shipping cargo, comprising the steps of:

providing said liner having four elongated panels of impervious film adapted

to substantially match the elongated sides, top and bottom of said container and first and second end panels to complete said liner;

cutting an access opening along at least one side panel adapted for loading and unloading said cargo;

positioning said liner in the container;

erecting the liner to substantially fill the same;

transferring said cargo through said opening; and

closing the opening to seal said liner against moisture to protect the cargo.

10. The method of installing a liner of Claim 9, wherein is further provided the step of:

attaching an open ended tube to said one side panel to mate with the opening; and

passing said cargo through both said tube and said opening during transfer.

11. The method of installing a liner of Claim 10, wherein is further provided the step of:

holding open the free end of said tube overhead by lifting the upper corners and for protection from increment weather during cargo transfer.